

REMARKS

Thank you for your indication of allowable subject matter. Please reconsider this application in view of the above amendments and the following remarks.

- Claims 1-32 are pending.
- Claims 1-4, 7-9, 11, 12, 15-17, 19, 20, 23, and 24 are rejected.
- Claims 5, 6, 10, 13, 14, 18, 21, and 22 are objected to.
- Claims 25-32 are newly added.

Newly added claims 25-32 correspond in scope to Claims 5, 6, 10, 13, 14, 18, 21, and 22 written in independent form, respectively. Since the current office action states that Claims 5, 6, 10, 13, 14, 18, 21, and 22 would be allowable if rewritten in dependent form, Applicant trusts that these claims are allowable. They do not add new matter.

Applicant notes the Examiner's discussion of the allowable subject matter in Claims 5, 6, 10, 13, 14, 18, 21 and 22. Applicant trusts that the Examiner is following the guidelines of MPEP §1302.13 when preparing these statements, which caution against implying that all of the reasons for allowance have been stated. Therefore, Applicant treats these statements of allowable subject matter as delineating some reasons why the claimed subject matter is allowable, not all of the reasons the material is allowable. Moreover, Applicant specifically points out that these claims are not limited to the literal language contained in the Examiner's discussion. Finally, Applicant states for the record that each of these claims is allowable over the prior art based on the entire record, not just based on the Examiner's discussion of allowable subject matter.

Each of the independent claims recites "a means for applying a coating composition". This limitation is implied by the previous language: "a chamber in which a coating composition comprising a coating solvent can be applied to an implantable device". Therefore, this amendment does not add new matter.

References cited during prosecution:

U. S. Patent No. 6,372,283, to Shim et al.	D1
U. S. Patent No. 5,370,684, to Vallana et al.	D2
U. S. Patent No. 6,383,215, to Sass et al.	D3

D1 teaches cleaning the substrate of pyrolytic carbon with acetone, coating the substrate with a silane, and drying the silane-coated substrate. After these procedures, the substrate is placed into a plasma reactor, and a mixture of inert gas and film-forming monomer is introduced into the chamber, where it undergoes plasma deposition. After a set amount of time, the reactor is disassembled, and the shims are removed. At this point, the shims can be primed or coated with liquid silicone rubber.

The Examiner has rejected claims 1-3, 7-9, 11, 15-17, 19, 23, and 24 under 35 USC §103(a) as being unpatentable over D1 in view of D3.

In order for D1 combined with D3 to make the claims of the instant application obvious, the combination must teach or make obvious each and every element of the rejected claims.

The current combination fails to do so. All independent claims of this rejection currently recite "a means for applying a coating composition comprising a coating solvent to an implantable device". But D1 teaches only a pressure controlled plasma reactor. D3 does not supply this missing feature; it teaches using a CVD process to coat a stent. Part of that process includes depositing a particular composition including a solvent into an accommodation vessel placed within a vacuum chamber followed by generating a vacuum in the chamber. (D3, Col. 5, line 59, to Col. 6, line 25). This does not teach that a coating composition comprising a coating solution is applied to the implantable device. One of ordinary skill in the art would expect the CVD process to vaporize the material placed into the accommodation vessel. If one were to use the CVD process of D3, the coating composition, as the composition contacts the medical device, would

not comprise a coating solvent—skilled artisans would expect the solvent to vaporize and not re-deposit.

Since the combination of D1 and D3 fail to meet this feature of the independent claims, the Examiner has not made out prima facie obviousness. Please remove this rejection of the independent claims.

Claims 2-8, 10-16, and 18-24 depend from Claims 1, 9, and 17, respectively and contain all the limitations of these claims. This makes the dependent claims patentable over D1 in view of D3 for at least the same reasons that were discussed for the independent claims. Please remove the rejection of these claims, as well.

Moreover, because this rejection does not amount to prima facie obviousness or anticipation, Applicant is under no duty to address the remainder of the Examiner's discussion in this section of the office action including the discussion of the dependent claims. But should such a duty arise in the future, Applicant reserves the right to address that discussion then. Applicant specifically does not acquiesce to the facts, assumptions, or reasoning contained in this section of the office action.

Furthermore, one of ordinary skill in the art would not substitute CVD processing steps or techniques into a plasma deposition process, which means that one of ordinary skill in the art would not make the combination cited by the Examiner. Skilled artisans normally carry out plasma deposition absent extraneous materials, such as solvents. The Examiner has not explained why a skilled artisan would start with a plasma deposition teaching to arrive at the apparatus for solution-based coatings of the current invention. The only way to arrive at these references is through hindsight reconstruction; without the guide of Applicant's claims, the Examiner would not have assembled these references.

Therefore, prima facie obviousness is lacking for this separate reason, as well. Please remove this obviousness rejection.

The Examiner has rejected claims 4, 12, and 20 under 35 USC §103(a) as being unpatentable over D1 combined with D3 and further in view of D2.

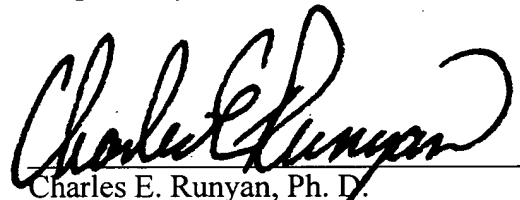
The comments set out above for the combination of D1 and D3 apply equally here to the combination of D1, D2, and D3. D1 and D3 are not properly combinable for at least the reasons listed above. Therefore, the D1, D2, and D3 combination is not properly combinable for at least those same reasons. (Applicant reserves the right to address other reasons that the D1, D2, and D3 combination is improper, if a need to do so arises in the future.)

Similarly, D1 combined with D3 fails to teach a coating composition comprising a coating solution applied to the implantable device, as discussed above. D2 does not supply this missing feature.

Therefore, this combination fails to amount to prima facie obviousness for at least these two reasons. Please remove this obviousness-based rejection.

Since all claims are in a condition for allowance, please issue a Notice of Allowability so stating. If I can be of any help, please contact me.

Respectfully submitted,



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